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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/506,992	04/12/2005	Yoshiyuki Udagawa	258513US0PCT	1958
22850 7590 08/13/2008 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
WYROZEDSKI LEE, KATARZYNA I				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
08/13/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/506,992

Applicant(s)

UDAGAWA ET AL.

Examiner

Katarzyna Wyrozebski

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-11 and 13-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-11 and 13-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S5108)
Paper No(s)/Mail Date 5/22/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

In view of applicants response dated 5/22/2008 following office action is final as necessitated by amendment. Applicants' arguments have been considered but are not found as persuasive. Examiner of record acknowledges cancellation of claims 3, 12 and 20. Claims 1, 2, 4-11, 13-19 are pending.

Examiner also acknowledges IDS submitted after first office action has been issued. Since the IDS submitted, contains office action that is considered as not publicly available to everyone, the reference is not considered.

Priority Documents – only PCT documents have been received. File is still missing JP priority documents.

Double Patenting

Double Patenting rejection of record over US 6,727,307 is hereby overcome, since the applicants have cancelled rejected claims. Double Patenting over teachings of 10/129,330 is maintained.

Claim Rejections - 35 USC § 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1, 2, 4-10 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by KONDO (US 6,727,307).

The discussion of the disclosure of the prior art KONDO from paragraph 5 of the office action dated 1/22/2008 is incorporated here by reference. The prior art of KONDO still applies against present claims since the disclosed therein rosinate compound Contains carboxyl group.

3. Claims 1, 2, 4-11, 13-19 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by KONNO (S 2004/0030027).

The discussion of the disclosure of the prior art KONNO from paragraph 6 of the office action dated 1/22/2008 is incorporated here by reference. The prior art of KONDO still applies against present claims since the disclosed therein compound contains carboxyl group.

4. Claims 1, 2, 5-11 are rejected under 35 U.S.C. 102(a) as being anticipated by GORL (US 6,882,036) in view of evidence provided in THIBON (US 2,656,250).

The discussion of the disclosure of the prior art GORL and evidence of THIBON from paragraph 7 of the office action dated 1/22/2008 is incorporated here by reference. The prior art of GORL still applies against present claims since the disclosed therein compound contains carboxyl group.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims are rejected under 35 U.S.C. 103(a) as being unpatentable over GORL (US 6,882,036) in view of THIBON (US 2,656,250).

The discussion of the disclosure of the prior art GORL and THIBON from paragraph 11 of the office action dated 1/22/2008 is incorporated here by reference. The prior art of GORL and THIBON still applies against present claims since the disclosed therein compound contains carboxyl group

7. Claims are rejected under 35 U.S.C. 103(a) as being unpatentable over GORL (US 6,882,036) in view of TSUJI (US 6,807,941).

The discussion of the disclosure of the prior art GORL and TSUJI from paragraph 12 of the office action dated 1/22/2008 is incorporated here by reference. The prior art of GORL and THIBON still applies against present claims since the disclosed therein compound contains carboxyl group.

Response to the Applicant's Arguments

In their response dated 5/22/2008 the applicants argued following:

a) The prior art of KONDO – applicants indicated that the surfactant of KONDO is not mixed with the filler and rubber.

The instant claims as presented before the office calls for mixing filler, carboxylate compound and rubber, however; it does not provide and specific order in which they have to be mixed. Therefore rosinate compound of KONDO can be mixed into the composition at any time as long as the three components end up together.

b) The prior art of KONNO – the applicants argued that there is no disclosure of carboxyl containing compound.

Table 5 – stearic acid

Col. 15 KONNO ads a rubber containing carboxylate group, which also falls within broad description of applicant's claim.

Col. 9 KONNO discloses use of coagulating agents that comprise carboxylate group. Applicants' carboxylate compound can be virtually anything suitable for use or making rubber composition. Claim 1 is that broad.

Col. 7 discloses surfactant, which also contain carboxylate group.

The applicants also argued that there is no disclosure of preparing aluminum containing suspension whose pH is controlled between 5.1 and 8.4.

Aluminum multivalent salt is disclosed in col. 7 of KONNO. It is utilized in aqueous emulsion or suspension with cationic surfactant, wherein the surfactant is listed right above it. The coagulating step of the rubber is disclosed in col. 8 where the pH is held within 3-12.

c) the prior art of GORL – as applicants indicated fails to teach inorganic compound of the instant invention.

Considering that both integers m and n as disclosed in independent claims can be zero, the simplest inorganic compound that can be utilized with the rubber of the instant invention is alumina. Aluminum as well as aluminum hydroxide filler is clearly envisaged in col. 6 of the prior art.

Applicants further argued that the filler of GORL is pretreated with organosilicon, which limitation is not excluded by the instant claims. Instant claims clearly indicate that a filler or filler precursor can be utilized and do not exclude presence of coupling agents.

The examiner however, removed claims 13-19 from anticipation rejection, since the main focus of the teachings of GORL is silicate. However, since the prior art of GORL discloses aluminum based fillers, use of these fillers would have been more obvious to one of ordinary skill in the art.

d) Double Patenting rejection over co-pending application 10/129,330 is maintained as it discloses composition comprising the same components as well as method including the pH of the composition. Aliphatic acid is disclosed in claim 51 of the co-pending invention.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katarzyna Wyrozebski whose telephone number is (571) 272-1127. The examiner can normally be reached on Mon-Thurs 8:30 AM-2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1796

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Katarzyna Wyrozebski/
Primary Examiner, Art Unit 1796
August 8, 2008